

### **REMARKS**

The present Amendment and accompanying RCE are submitted in response to the Final Rejection dated July 21, 2009, as well as the Advisory Action dated November 2, 2009. The appropriate fees, including a fee and petition for a one month extension of time are included herewith.

The RCE requests entry and consideration of Applicants' October 20, 2009 Response, as well as the amendments requested herein.

Claims 17-19, 21, 22 and 29-34 are pending. Claims 17-19, 21 and 22 stand withdrawn. Applicants renew their request that upon allowance of claim 29 that claims 17-19, 21 and 22 be recombined with examined claims 29-31 and contemporaneously allowed. Claims 29 and 30 are currently amended relative to Applicants' October 20, 2009 Response. No new matter has been added.

### **Correspondence Address Change**

Applicants note from PAIR that the correspondence address has recently been changed, but the Power of Attorney filed April 30, 2009 has not yet processed. Confirmation that all PTO records have been corrected to include a Power of Attorney to the undersigned attorneys at Customer No. 24998 is requested.

### **Response to Rejection under 35 USC § 112, second paragraph**

Claims 29-34 have been rejected under 35 U.S.C. 112, second paragraph, because the phrase "protruding from the side surface" at line 12 of claim 29 is allegedly indefinite. Claim 29 was previously amended to recite "protruding from said *opposing* side surface." In addition, claim 29 has now been amended to recite that the previously recited "plate member edge" delineates the bone facing and opposing side surfaces. In view of these Amendments, the claims are submitted to be definite, and the rejection under § 112 should be withdrawn.

**Response to Rejection under 35 USC § 103**

Claims 29, 31-32, and 34 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Herzberg (U.S. Patent No. 4,988,350) in view of Sioufi (U.S. Patent No. 5,409,489). It remains Applicants' position, for reasons stated in the October 20, 2009 Response, that this rejection is improper.

In the final rejection mailed on July 21, 2009, the Examiner initially discusses the teaching of the Herzberg patent:

Herzberg [] discloses an implant plate [with] at least one receiving member (129) protruding from the plate (Fig. 18, 129), that is located on the head portion and is considered proximate to the edge. Flexible members such as cerclage wires may be passed through these receiving members and then tightened to assist in securing the bone plate to the bone surface for fixation.

The Examiner then expressly acknowledges Herzberg fails to teach or suggest, *i.e.*, "discrete, circumferentially enclosed apertures that extend from the bone plate for securing flexible members." (Office Action, page 3). These deficiencies are allegedly remedied by the Sioufi patent. The Examiner posits that modifying the cut-outs of Herzberg to be closed, in a manner like the stabilizing hook receiving eyelets 88 of Sioufi "would ensure that the flexible members used to secure the plate do not more (sic: move) or become dislocated."

One of ordinary skill in the art would recognize that the cut-outs of Herzberg are more akin to depressions than "protrusions." Further, as acknowledged by the Examiner, the "cut-outs" are not discrete. Herzberg makes clear that bent-over sections 126', 126", each encompassing multiple cut-outs, are contiguous with and an integral part of plate 25 (9/45-56):

Said connecting device 70 consists of a bending or folding over of the circumferential edge 125 of the plate-shaped and spoon-like constructed section 25 of the trochanter supporting plate 20 within the rearward area of the latter. This bent-over circumferential section 126 is constructed essentially within the central lateral areas 125a, 125b of the circumferential edge 125 of the section 25 and thus extends to

both sides of the section 25 of the trochanter supporting plate 20, so that two individual sections 126', 126" are formed. The ends of the two individual areas 126', 126" taper conically on both sides (FIG. 17).

To make the cut-outs of Herzberg "discrete" would require elimination or complete redesign of Herzberg's "bent-over circumferential section 126," and therefore impermissible restructuring of Herzberg's spoon shaped plate design. *See In re Ratti*, 270 F.2d 810, 812 (CCPA 1959) ("We hold, further, that the combination of Jepson with Chinnery et al. is not a proper ground for rejection of the claims here on appeal. This suggested combination of references would require a substantial reconstruction and redesign of the elements shown in Chinnery et al. as well as a change in the basic principles under which the Chinnery et al. construction was designed to operate.") Further, to the extent that the Examiner contemplates merely closing off the top of the cut-out, the continuity of the edge profile would be changed without any apparent benefit.

The Examiner further states as follows:

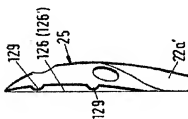
Herzberg discloses the claimed invention except for discrete, circumferentially enclosed apertures that extend from the bone plate for securing flexible members. Sioufi discloses a plate with a head and shaft portion that also has circumferentially enclosed apertures (88) extending from the side of the plate at the head end. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Herzberg having the receiving member replaced with circumferentially enclosed apertures as taught by Sioufi, as doing so would ensure that the flexible members used to secure the plate do (sic: to) not more (sic: move) or become dislocated.

Although the Examiner conjectures why the cut-out could be modified, Applicants can find no teaching in Herzberg that could convey to one of ordinary skill in the art that Herzberg's structure is deficient in any way to warrant the redesign proposed by the PTO. This is especially so since the proposed modification would complicate the manufacturing technique contemplated by Herzberg, and possibly also complicate the method of using the plate, without any real benefit. The alleged reason is to better "secure" the plate or prevent its dislocation. Any benefit that may be provided does not seem to outweigh the negative impact of the proposed modifications. There is

clearly no sufficient articulated reason to justify the suggested modification. See *KSR Int'l Co. v. Teleflex Inc. et al.*, 127 S.Ct. 1727, 1741 (April 30, 2007):

[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness).

More specifically, Herzberg simply cuts out edge material from the spoon shaped plate material, and then bends opposing edges. Herzberg merely lays the cerclage wire in an edge depression. The Examiner's proposed redesign replaces cut-outs ("edge depressions") with closed eyelets. Forming circumferentially enclosed openings in edge 126, which is formed from a spoon shaped plate material, would require that the height of the edge 126 double in size, as the illustrated cut-out does not even appear to be a full semi-circle. Figure 18 below shows a side view of the spoon shaped plate:



The Examiner provides no articulated reason why one of ordinary skill in the art would make this modification. The proposed redesign would complicate the manufacturing technique by now requiring formation of a more complex plate edge. One of ordinary skill in the art would not do this.

The proposed change would likely alter the profile of edges 126 of the Herzberg plate. The Examiner provides no articulated reason why one of ordinary skill in the art would do this. Replacing the edge depressions of Herzberg with closed eyelets would require threading a wire through an opening in contrast to simply laying a wire in a depression. The procedure would likely be more time consuming and more complicated. One of ordinary skill in the art would not want to prolong and complicate a medical procedure.

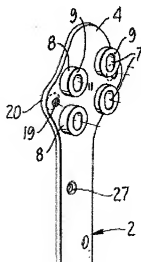
### **Advisory Action**

In the Advisory Action, the Examiner posits that prior to Applicants' October 20, 2009 Amendment, Applicants' recitation "the side surface" in the 3rd paragraph of claim 29 allegedly permitted Herzberg's "thin side spines" to read on Applicants' recited "side surface." Applicants disagree, especially since the first recitation of "side surface" in claim 29 was clearly in the context of the surface opposite the plate's "bearing" surface and defined by the "edge" of the plate member. Claim 29 clearly identified which "side surface" was being referenced:

a plate member having an edge defining a head-end portion shaped to bear against a surface of a bone [] plate member having a bone facing surface to bear against the bone and an opposing side surface facing away from the bone.

One of ordinary skill in the art must consider all the claim terms, and therefore the interpretation proffered by the Examiner would not be reasonable or consistent with the specification.

In the Advisory Action, the Examiner also identifies a newly cited prior art reference, Wagner U.S. Patent No. 3,842,825. The Examiner asserts that claim 29 as amended on October 20, 2009 reads on Wagner. Applicants disagree. Wagner discloses a fixation device having a head portion with four screw bores, each circumscribed by a boss 8, and illustrated in-part below:



The Examiner alleges that if two of the screw bores are read on Applicants' claimed "a plurality of holes," then the other two screw bores of Wagner read on Applicants' claimed protruding members. Wagner makes clear that the four screw bores are identical and have the same function. There is nothing in Wagner to suggest that these components be eliminated as the Examiner suggests which would change the operation of Wagner's device. See *In re Ratti*, 270 F.2d 810, 812 (CCPA 1959).

The Examiner also asserts that Wagner's "bores are fully capable of being used with a flexible member to attach bone. Applicants disagree, because the use of Wagner's device with only two screws would very likely block access to other screw bores, thus preventing passage of a wire. In addition, the proposed interpretation of Wagner would require one of ordinary skill in the art to completely disregard the cover plate 16 which is used to prevent the loosening of the bolts 10 Column 1, lines 51-59. *Id.*

### **Conclusion**

For reasons given above, the rejection of claims 29, 31-32, and 34 is improper and should be withdrawn. Claims 30 and 33 both depends from claim 29, and are submitted to be allowable for the same reasons. In addition, the PTO's reliance upon the Wagner patent appears misplaced for reasons given *supra*.

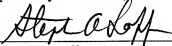
Accordingly, in view of the above amendments, Applicants submit that the present application is in condition for allowance.

**Authorization**

The Director is hereby authorized to charge any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1073, under Order No. A8130.0659/P659.

Dated: November 10, 2009

Respectfully submitted,

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